IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

AF# 3713

RESPONSE UNDER RULE 116
EXPEDITED HANDLING PROCEDURES

In re Patent Application of

OKADA et al.

Serial No. 09/982,075

Filed: October 19, 2001

Atty Dkt. 723-1190
C#/M#
Group Art Unit: 3713
Examiner: A. Enatsky
Date: March 27, 2003

Corres. and Mail
BOX AF

Title: PORTABLE COLOR DISPLAY GAME MACHINE AND STORAGE MEDIUM FOR THE SAME

#9
EOT(1)
S. Zimmerman

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE/AMENDMENT/LETTER

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

☐ **Correspondence Address Indication Form Attached.**

Fees are attached as calculated below:

Total effective claims after amendment **18** minus highest number Previously paid for **20** (at least 20) = 0 x $ 18.00			$ 0.00
Independent claims after amendment **4** minus highest number Previously paid for **4** (at least 3) = 0 x $ 84.00			$ 0.00
If proper multiple dependent claims now added for first time, add $280.00 (ignore improper)			$ 0.00
Petition is hereby made to extend the current due date so as to cover the filing date of this Paper and attachment(s) ($110.00/1 month; $410.00/2 months; $930.00/3 months)			$ 110.00
Terminal disclaimer enclosed, add $ 110.00			$ 0.00
☐ First/second submission after Final Rejection pursuant to 37 CFR 1.129(a) ($750.00) ☐ Please enter the previously unentered , filed ☐ Submission attached			$ 0.00
	SUBTOTAL		$ **110.00**
If "small entity," then enter half (1/2) of subtotal and subtract ☐ Applicant claims "small entity" status. ☐ Statement filed herewith			-$ 0.00
Rule 56 Information Disclosure Statement Filing Fee ($180.00)			$ 0.00
Assignment Recording Fee ($40.00)			$ 0.00
Other:			**0.00**
	TOTAL FEE CHARGED TO DEPOSIT ACCOUNT		$ **110.00**

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TECHNOLOGY CENTER R3700

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYE P.C.
By Atty.: Michael J. Shea, Reg. No. 34,725

Signature: Michael J. Shea

03/28/2003 CCHAU1 00000008 141140 09982075

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Req Reconsideration
S. Zimmerman

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	**BOX: AF**
OKADA *et al.*	Atty. Ref.: 723-1190
Serial No. 09/982,075	Group: 3713
Filed: October 19, 2001	Examiner: A. Enatsky

For: PORTABLE COLOR DISPLAY GAME MACHINE AND STORAGE MEDIUM FOR THE SAME

* * * * * * * * * * *

March 27, 2003

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

REQUEST FOR RECONSIDERATION

This paper is responsive to the office action dated November 27, 2002 (for which petition is hereby made for a one-month extension of time)

Reconsideration and allowance of the subject patent application are respectfully requested.

Applicants once again request reconsideration of the request to "remove the incorporation by reference to the provisional applications." 37 C.F.R. 1.14(c)(1)(i) sets forth conditions under which the USPTO will provide a copy of an application-as-filed or a file wrapper and contents to the public:

> (c) *When copies may be supplied.* A copy of an application-as-filed or a file wrapper and contents may be supplied by the Office to the public, subject to paragraph (i) of this section (which addresses international applications), if the any of the following apply:
>
> (1) *Application-as-filed*
>
> (i) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. Section 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be

provided to any person upon written request including the fee set forth in §1.19(b)(1)...

The subject patent application was published as Publication No. 2002-00399924-A1 on April 4, 2002. In accordance with the provisions of 37 C.F.R. 1.14(c)(1)(i) set forth above, copies of the provisional applications incorporated in this application are indeed available to the public, contrary to the assertion in the office action. Accordingly, the incorporation by reference of the provisional applications into the subject application is entirely proper.

Claims 21, 22, 33 and 38-40 were rejected under 35 U.S.C. Section 103(a) as allegedly being unpatentable over Shirashi *et al.* (U.S. Patent No. 4,981,296). Independent claim 21 is directed to a game program storage medium that stores clock speed data usable by a portable game machine in a process for setting a clock speed of a processor of the game machine. Claim 22 is directed to a portable storage device that stores video game instructions, wherein the instructions include a command for causing a microprocessor of a portable game machine to be set at one of a plurality of different processing clock speeds. Claim 33 is directed to a hand-held display system including processing circuitry that uses a processing speed attribute of a computer-readable medium in order to set a processing speed for processing a video game. Finally, claim 40 is directed to a method of setting a processing speed of a hand-held display system comprising determining if a video game program includes a processing speed instruction and, if so, setting the processing speed in accordance with that instruction.

As discussed in the prior response, Shiraishi *et al.* discloses a data processing device in which an operator is able to change the data processing speed of a microprocessor (*i.e,* either standard or slow speed). Figure 4 shows a set-up menu for changing the processing speed. There is no disclosure or suggestion in Shiraishi *et al.* of providing a game storage medium or

storage device with data used to set the clock speed of a game machine microprocessor. Shiraishi *et al.* likewise does not disclose or suggest a storage device including a speed setting attribute or a method involving determining if a video game program includes a processing speed instruction and, if so, setting the processing speed in accordance with that instruction. In Shiraishi *et al.*, the operator may set the speed to something other than the most suitable speed, thereby adversely impacting video game data processing. The claimed arrangements can be used to ensure that the microprocessor speed is set at the most suitable speed for a particular video game.

Bereft of documentary evidence showing the claimed features, the office action nonetheless concludes that the rejected claims would have been obvious because "it (sic) obvious to automate a manual process." Significantly, however, there is no showing in the office action that automation of the operator's speed setting in the Shiraishi *et al.* system would necessarily be accomplished as set forth in the pending claims. The *Response to Arguments* section of the office action further alleges, "automating a manual process is notoriously well-known, especially in electronic systems." Citation is made to *In re Venner* to support the conclusion of obviousness. However, the *Venner* case was decided more than a decade before the before the Supreme Court's decision in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) which sets forth the factual inquiry to be conducted in an obviousness determination. Predicating the legal determination of obviousness on a generalized statement that "it is obvious to automate a manual process" improperly dispenses with the factual inquiry mandated by *Graham* and extensive Federal Circuit precedent based thereon. It is for reasons like this that the

Federal Circuit has expressly rejected conclusory reliance on allegedly *per* se obviousness rules as discussed in the prior response.[1]

For at least these reasons, Applicants submit that claims 21, 22, 33 and 38-40 would not have been rendered obvious by Shiraishi *et al.*

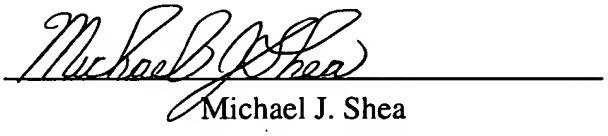
Claims 25, 27-29, 34, 36 and 37 were rejected under 35 U.S.C. Section 103(a) as allegedly being unpatentable over Shiraishi *et al.* in view of Sanemitsu (U.S. Patent No. 6,209,043). Claims 26, 30 and 35 were rejected under 35 U.S.C. Section 103(a) as allegedly being obvious over the proposed Shiraishi *et al.*-Sanemitsu combination, in further view of Goshima *et al.* (U.S. Patent No. 4,204,728). This application claims priority to Application No. H10-145620, filed in Japan on May 27, 1998. This pre-dates the effective U.S. filing date of Sanemitsu (*i.e.*, October 30, 1998). Applicants submit herewith a certified translation of the Japanese priority application and respectfully submit that it provides full support for the claims rejected based on proposed combinations involving Sanemitsu. Accordingly, Applicants respectfully request withdrawal of the rejections involving Sanemitsu. Applicant emphasize that the submission of a certified translation of Japanese Application No. 10-145620 does not constitute (and should not be construed to constitute) acquiescence in any aspect of the rejections of claims 25-30 and 34-37 set forth in the office action.

[1] It is also believed to be improper to rely on case law to supply the very claim limitations that admittedly are not found in the applied prior art. *See* MPEP Section 2144 ("If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.").

Applicants submit that the pending claims are allowable and early notice to that effect is respectfully requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 

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